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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/689,721	08/12/96	PERRY	A

MM71/0730

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EXAMINER
LUEBKE, R

ART UNIT	PAPER NUMBER
2832	

DATE MAILED: 07/30/98

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/689,721

Applicant(s)

Perry

Examiner

Renee S. Luebke

Group Art Unit

2832



☒ Responsive to communication(s) filed on Jul 20, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 6 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 6 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The substitute specification filed July 20, 1998 has not been entered because it does not conform to 37 CFR 1.121(a) or 1.125.

§1.125 Substitute specification.

If the number or nature of the amendments shall render it difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification, including the claims, or any part thereof, to be rewritten. A substitute specification may not be accepted unless it has been required by the examiner or unless it is clear to the examiner that acceptance of a substitute specification would facilitate processing of the application. Any substitute specification filed must be accompanied by a statement that the substitute specification includes no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

The abstract as filed on August 6, 1996 and the substitute specification as filed on June 2, 1997 are still presently of record and are considered below.

Contrary to applicant's remarks, the examiner did not require a substitute specification. During an informal telephone conversation, the examiner merely repeated the requirement that IF ~~a~~ substitute specification is submitted, it must be submitted properly. As noted in the Office action of March 17, 1998, the earlier substitute specification was not properly submitted. In reference to the substitute specification of July 20, 1998, it is noted that no substitute specification was required and that it includes new matter (for example, the alternate method of use described at the bottom of page 4). Therefore, it was not entered.

2. The substitute specification, filed June 2, 1997, remains objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure includes the following:

- a. The requirement that the ring be "a few thousandths of an inch larger" than the recorder. This was not shown since the original drawings did not clearly show the relationship between the inside of the ring and the recorder. If anything, it appeared to show that they were essentially the same size. The measurement of "a few thousandths" certainly could not have been determined.

b. The use of a "thin cloth material" for the strap was not disclosed. Whether or not a particular material or structure "is a well known equivalent" is irrelevant to the issue of new matter.

c. The use of a "simple over-hand" knot was not originally disclosed. The original drawings were not sufficiently clear to discern the type of knot used and the specification was silent on this issue.

d. The suggestion that the principle may be "extended to applications involving other musical instruments or objects" was not originally presented.

Applicant is required to cancel the new matter in the response to this Office action.

It is noted that the original specification, filed August 12, 1996, contained no information about materials, dimensions or methods of use and assembly. It is this disclosure from which the designation of new matter is made.

3. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the original specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. In particular, the original specification did not contain information concerning the method of using the device.

4. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the claim~~s~~ is indefinite because there is an inconsistency throughout the claim. The claim initially indicates that the subcombination, a method for suspending a recorder, is being claimed. However, the claim also contains positive limitations directed toward the recorder, suggesting that applicant intends to claim the combination of the recorder and its suspension method. Applicant is required to clarify what subject matter

the claim is intended to be drawn to and the language of the claim must be amended to be consistent with this intent.

- ✓ The claim lacks antecedent basis for "the neck" on line 1.
- ✓ On line 11, it appears that "the lower" should be -the lower section-.

The claim contains both products (specific limitations drawn to the recorder and the suspension device) and the process of using and, therefore, is seen to be indefinite. As noted in MPEP §2173.05(p), a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 6 is rejected under 35 U.S.C. 101 because the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.

7. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. It is suggested that responses to this final action be faxed to:

(703) 308-7722, 308-7724 or 308-7382

This facsimile transmission service for formal amendments is provided as part of Technology Center 2800's After Final program to improve communication with our customers. Use of this program reduces processing time, will result in more timely responses by the Office and should result in fewer requests for extensions of time. Please refrain from sending a confirmation copy, as noted in 37 CFR 1.6(d) and 1.8(b).

For formal communications, please mark "EXPEDITED PROCEDURE"

For informal or draft communications please clearly label "PROPOSED" or "DRAFT"

Alternatively, responses may be mailed to:

Box AF

Assistant Commissioner for Patents

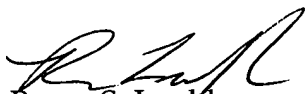
Washington, DC 20231

Hand-delivered responses should be brought to:

Crystal Plaza 4, Fourth Floor (Receptionist)

2201 South Clark Place, Arlington, Virginia.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. Renee Luebke at (703) 308-1511. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Gellner, can be reached at (703) 308-1721.



Renee S. Luebke

Primary Patent Examiner

July 29, 1998